Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ALAN N. HOUGHTON,
CLARISSA NAFTZGER,
VIJAYASARADHI SETALURI, and
POLLY GREGOR

Appeal No. 2004-1709
Application No. 09/627,694

ORDER REMANDING TO THE EXAMINER

Before WILLIAM F. SMITH, MILLS, and GREEN, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and to take appropriate action.

1. Subject Matter on Appeal.

This appeal involves claims 31 and 33 which read follows:

31. A non-human cell line expressing a human differentiation antigen, wherein the human differentiation antigen is derived from human melanocytes and wherein the cell line is an insect cell line.

33. The cell line of claim 31, wherein the human differentiation antigen is gp75.

2. Obviousness.

Claims 31 and 33 stand rejected under 35 U.S.C. § 103(a) with the examiner relying upon Houghton[1] and Ausubel[2] as evidence of obviousness. In presenting their case on appeal, appellants rely upon the results set forth in Examples 1 and 3 of the present specification as evidence of nonobviousness. See, e.g., Appeal Brief, pages 5-6; Reply Brief, page 2.

In reviewing the Examiner's Answer, we do not find that the examiner has directly responded to appellants' reliance upon Examples 1 and 3 as evidence of nonobviousness. As set forth in In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986):

> If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Upon return of the application, the examiner should take a step back and review the merits of the rejection under 35 U.S.C. § 103(a) taking into account the results set forth in Examples 1 and 3 of the present specification. If the examiner determines that

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[1] Houghton et al. (Houghton), "Recognition of Autoantigens by Patients with Melanoma," Annals New York Academy of Sciences, Vol. 690, pp. 59-68 (1993)

[2] Ausubel et al. (Ausubel), "Expression of Proteins in Insect Cells Using Baculoviral Vectors," Current Protocols in Molecular Biology," Vol. 2, Supplement 10, Units 16.8.1-16.8.5, 16.91-16.9.6, 16.10.1-16.10.8, and 16.11.1-16.11.7

the subject matter of claims 31 and 33 remains unpatentable under this section of the statute, the examiner should set forth a complete statement of the rejection including the reasons why the evidence provided by Examples 1 and 3 of the present specification ~~are~~ is not a sufficient rebuttal.

3. Double Patenting.

This application is stated to be a continuation-in-part of Application No. 09/308,697, now U.S. Patent No. 6,328,969 ('969 patent). Claims 13-17 of the '969 patent read as follows:

13. A non-human cell line expressing a human differentiation antigen.

14. The cell line of claim 13, wherein the cell line is an insect cell line.

15. The cell line of claim 13, wherein the human differentiation antigen is derived from human melanocytes.

16. The cell line of claim 15, wherein the cell line is an insect cell line.

17. The cell line of claim 15, wherein the human differentiation antigen is gp75.

As seen, claim 16 of the '969 patent appears to be an exact duplicate of claim 31 pending in this application. In addition, claim 17 is similar to claim 33 on appeal with the exception that claim 17 does not explicitly require that the cell line be an insect cell line.

Upon return of the application, the examiner should consider the effect of the '969 patent on the patentability of claims 31 and 33. It appears that claims 31 and 33 of this application are either exact duplicates or obvious variants of the claims set forth in the '969 patent.

4. Future Proceedings.

If the examiner believes that the claims pending in this application are unpatentable either on obviousness grounds or double patenting grounds, the examiner should issue an appropriate Office action setting forth such a rejection and provide appellants a full and fair opportunity to respond. In this regard, we state that we are not authorizing a Supplemental Examiner's Answer under 37 CFR § 1.193(b)(1).

REMANDED

William F. Smith
Administrative Patent Judge

Demetra J. Mills
Administrative Patent Judge

Lora Green
Administrative Patent Judge

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